APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,788	04/09/2001	Khai Hee Kwan		8886

23336 7590 09/10/2004		EXAMINER	
KHAI HEE KWAN		RHODE JR, ROBERT E	
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RANDWICK, 2031		ART UNIT	PAPER NUMBER
AUSTRALIA		3625	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)
Office Action Summary	09/827,788		KWAN, KHAI HEE
	Examiner		Art Unit
	Rob Rhode		3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-20_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-20_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _09 April 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 1 is objected to because of the following informalities: Some of the claim steps do not begin with a verb such as validating. Rather the applicant will either use an "if" statement or with a word such as "in" (see 6th step). For example, the applicant could have recited "requesting in the payment processor a password". Additionally, the wording of the claim 1 steps is awkward, which makes interpreting the intent as well as the meets and bounds difficult to determine.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, the words used in the body of the claim such as "if both" is tentative language, which precludes the ability to determine meets and bounds of the claim. Moreover in Claim 1, the words/phrases "adjustment" and "book entry" are a relative word/phrase, which renders the claim step indefinite. The word " adjustment" and the phrase "book entry" are not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the word "adjustment" and the phrase "book entry" will be treated as a generic word.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states at steps 13 and 15 of claim 1, the phrase "end user". There is insufficient antecedent basis for these limitations in the claim.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps include after step 10 of "validating the debit".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 - 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Katz (US 6,424,706 B1) in view of Resnick (US

2001/0001321 A1) and further in view of Fox (US 6,560,581 B1).

Regarding claim 1 and related claim 17, Resnick teaches a computer network

method for paying for goods or services over the network using

telecommunication accounts through at least one telecommunication service

provider and a wireless communication device such as a mobile phone

comprising:

providing at least a centralized payment processor linked to the network (see at

least Figure 2); in the payer telecommunication service provider's processor,

upon authentication of the password or voice pattern will response as

authenticated to the payment processor over the network (see at least Para

0021); verification of purchase includes the step of downloading the text

message from the payer's mobile phone to the merchant's server using a

wireless coupling device and the encrypted message is matched against the

copy retrieved from the merchant's database (see at least Para 0033 and 34);

conducting a payment process initiated by the payer through the payee's point of

sale by validating the payer's required mobile phone number or account identifier

and the payee's account identifier (see at least Para 0030); if both confirmation

and authenticating steps are validated, the payer's telecommunication service

provider will record a debit entry with an amount of money equal to the payer's

payment amount in the monthly telecommunication bill, subject to adjustment

where the payer's account is an non-prepaid telecommunication account as

instructed by the payment processor over the network (see at least Para 0005);

However, Resnick does not specifically disclose a method for extending at least

one the telecommunication service provider's main processor for establishing sub

accounts for both payer and payee on the provider's main processor having a

corresponding account identifier to the main telecommunication account such as

their mobile or fixed line phone numbers where such sub accounts include

personal identification such as a password or a voice pattern of the payer and

payee in order to gain access; in the payment processor, upon receiving the

account identifier of both payer and payee, responding with confirming the

accounts with the respective telecommunication service provider's main

processor over the network ; in the payment processor, upon receiving a positive

response from the said to telecommunication service provider of the payer and

payee, responding with an activation code sent over the network to the payer and

initiating a connection to the payer's mobile phone to request the activation code

to be inputted either through the keypad or by speaking the code directly to the

microphone piece of the mobile phone so as to be validated, said response

includes an indication of approval if the validating step results in identifying and

confirming the transaction by assigning an unique transaction number; in the

payment processor, if both confirmation and authenticating steps are validated,

where the payer's account is a prepaid account, the step includes a further step

of verifying the availability of funds to affect the purchase and on confirmation

from the payer's telecommunication provider, the telecommunication service

provider will debit an amount of money equal to the payer's payment amount,

subject to adjustment as instructed by payment processor over the network; if

both confirmation and authenticating steps are validated, the payer's

telecommunication service provider will record a debit entry with an amount of

money equal to the payer's payment amount in the monthly telecommunication

bill, subject to adjustment where the payer's account is an non-prepaid

telecommunication account as instructed by the payment processor over the

network; if both confirmation, authenticating and debiting of the payer's account

steps are validated, the payment processor will sent an approval code to the

payee or merchant server and instruct the merchant's telecommunication service

provider where the merchant's sub account is held to record a credit entry with an

amount of money equal to the payer's payment amount on the merchant's

monthly telecommunication bill over the network, subject to adjustment where

such credit can be cashed out only when there is a net positive cash from the

total bill on settlement; at the payee or merchant's server, upon receiving this

approval code, requested goods or services will be deemed sold to the payer and

will be released according to the terms of sale over the network; at the

completion of payment process, both payer and payee or merchant will receive

an encrypted receipt detailing the purchase where the end-user will receive such

receipt as a text message into the mobile phone's memory storage and the

merchant's server upon receiving this receipt message over the network will

stored this into its database.

On the other hand, Katz teaches a method for extending at least one the

telecommunication service provider's main processor for establishing sub

accounts for both payer and payee on the provider's main processor having a

corresponding account identifier to the main telecommunication account such as

their mobile or fixed line phone numbers where such sub accounts include

personal identification such as a password or a voice pattern of the payer and

payee in order to gain access (see at least Col 4, lines 31 – 35 and 60 – 64).

Please note that Katz does disclose a password associated with a redemption

password. In that regard, it would have been obvious to one of ordinary skill in

the art to have a sub account with a password for the payer and payee.

in the payment processor, upon receiving the account identifier of both payer and

payee, responding with confirming the accounts with the respective

telecommunication service provider's main processor over the network (Col 15,

lines 6 – 17 and 60 – 65); in the payment processor, upon receiving a positive

response from the said to telecommunication service provider of the payer and

payee, responding with an activation code sent over the network to the payer and

initiating a connection to the payer's mobile phone to request the activation code

to be inputted either through the keypad or by speaking the code directly to the

microphone piece of the mobile phone so as to be validated, said response

includes an indication of approval if the validating step results in identifying and

confirming the transaction by assigning an unique transaction number (see at

least Abstract, Col 8, lines 50 – 51, Col 10, lines 11 – 14 and Col 21, lines 30 –

41); in the payment processor, if the validating step results in confirmation of the

transaction, the step of requesting for a password is initiated where the payer is

prompted to key in the password using the keypad or saying the password to the

microphone so as to authenticate the payer's identity, authorisation and

associating the accounts linkage for both payer and payee to the payment

transaction (see at least Abstract and Col 4, lines 33 – 41); in the payment

processor, upon receiving the password or voice pattern from the payer, this is

authenticated with the stored password or voice pattern at the payer's

telecommunication service provider in order to gain access to the payer's sub

account over the network (see at least Col 21, lines 36 – 38); if both confirmation

and authenticating steps are validated, where the payer's account is a prepaid

account, the step includes a further step of verifying the availability of funds to

affect the purchase and on confirmation from the payer's telecommunication

provider, the telecommunication service provider will debit an amount of money

equal to the payer's payment amount, subject to adjustment as instructed by

payment processor over the network; if both confirmation and authenticating

steps are validated, the payer's telecommunication service provider will record a

debit entry with an amount of money equal to the payer's payment amount in the

monthly telecommunication bill, subject to adjustment where the payer's account

is an non-prepaid telecommunication account as instructed by the payment

processor over the network (see at least Col 8, lines 24 – 29); if both

confirmation, authenticating and debiting of the payer's account steps are

validated, the payment processor will sent an approval code to the payee or

merchant server and instruct the merchant's telecommunication service provider

where the merchant's sub account is held to record a credit entry with an amount

of money equal to the payer's payment amount on the merchant's monthly

telecommunication bill over the network, subject to adjustment where such credit

can be cashed out only when there is a net positive cash from the total bill on

settlement (Col 5, lines 6 – 16 and Col 7, lines 44 – 49); at the payee or

merchant's server, upon receiving this approval code, requested goods or

services will be deemed sold to the payer and will be released according to the

terms of sale over the network (Col 4, lines 39 – 44); at the completion of

payment process, both payer and payee or merchant will receive an encrypted

receipt detailing the purchase where the end-user will receive such receipt as a

text message into the mobile phone's memory storage and the merchant's server

upon receiving this receipt message over the network will stored this into its

database (Col 10, lines 27 – 28). Please note that Katz does not specifically

disclose encryption. Encryption is old and well known to one of ordinary skill in

the art and thereby adding the encryption will increase security but at a

significant increase in cost. With the increased security, the payee as well as

payer trust will be enhanced.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have provided the method of Resnick with the method of Katz to

have enabled method for an end to end transaction for purchasing an item using

a mobile phone, telecommunications service provider and payment process as

well as prepaid minutes in lieu of money. Resnick discloses a method for

providing at least a centralized payment processor linked to the network; in the

payer telecommunication service provider's processor, upon authentication of the

password or voice pattern will response as authenticated to the payment

processor over the network (see at least Para 0021); verification of purchase

includes the step of downloading the text message from the payer's mobile

phone to the merchant's server using a wireless coupling device and the

encrypted message is matched against the copy retrieved from the merchant's

database (see at least Para 0033 and 34); conducting a payment process

initiated by the payer through the payee's point of sale by validating the payer's

required mobile phone number or account identifier and the payee's account

identifier (see at least Para 0030); if both confirmation and authenticating steps

are validated, the payer's telecommunication service provider will record a debit

entry with an amount of money equal to the payer's payment amount in the

monthly telecommunication bill, subject to adjustment where the payer's account

is an non-prepaid telecommunication account as instructed by the payment

processor over the network (see at least Abstract, Para 0005 and Figure 2). Katz

discloses an end to end transaction processing and updating method using a

mobile phone and per paid minutes (Abstract, Col 4, lines 33 – 41 and Col 10,

lines 10 – 15). Therefore, one of ordinary skill in the art would have been

motivated to extend the method of Resnick with a method for end to end

transaction processing and updating using a mobile phone and pre paid minutes.

The combination of Resnick and Katz substantially disclose the applicant's

invention.

However, the combination does not specifically disclose and teach a method for

providing the integrity of the receipt includes the step of uploading the encrypted

receipt text message from the payer's mobile phone using the reply function to

the payment processor server over the network for decryption upon which the

details of the transaction will be forwarded to the merchant originating the

transaction and a copy of the decrypted text message back to the end-user

where such copy may be printed out by way of a wireless printer connected to

the mobile phone.

On the other hand, Fox teaches a method for providing the integrity of the receipt

includes the step of uploading the encrypted receipt text message from the

payer's mobile phone using the reply function to the payment processor server

over the network for decryption upon which the details of the transaction will be

forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone (see at least Abstract and Col 3, lines 29 – 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Resnick and Katz with the method of Fox to have enabled a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone. The combination of Resnick and Katz disclose a method for providing at least a centralized payment processor linked to the network and all associated claim limitations with the exception of the last step. Fox discloses a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone (Abstract). Therefore, one of ordinary skill

in the art would have been motivated to extend the combination of Resnick and

Katz with a method for providing the integrity of the receipt includes the step of

uploading the encrypted receipt text message from the payer's mobile phone

using the reply function to the payment processor server over the network for

decryption upon which the details of the transaction will be forwarded to the

merchant originating the transaction and a copy of the decrypted text message

back to the end-user where such copy may be printed out by way of a wireless

printer connected to the mobile phone.

Regarding claim 2, Katz teaches a method wherein the payment is in the form of

monetary units (Col 10, lines 59 – 62).

Regarding claim 3, Katz teaches a method wherein the payment from the payer

is made as a direct debit transaction in the case of a prepaid telecommunication

account (Col 8, lines 24 - 28.

Regarding claim 4, Katz teaches a method wherein the payment is made from

the payer as a debit book entry transaction in the case of an non prepaid

telecommunication account where the payment amount is included in the billing

statement where the total bill includes regular telecommunication charges (Col

10, lines 59 – 61).

Regarding claim 5, Katz teaches a method wherein the payment is made to the

merchant or payee as a credit book entry in the case of non prepaid

telecommunication account and is including in the billing statement where the

total may be netted off with regular telecommunication charges (Col 10, lines 58

– 62).

Regarding claim 6 and related claim 7, Resnick teaches a method wherein the

purchase transaction is initiated at a point of sale by payer by connecting using

internet protocol or wireless application protocol (Figure 2).

Regarding claim 8, Katz teaches a method wherein the payer and payee sub

account are linked to their respective telephone or wireless telephone service

account at their telecommunication service provider (Col 5, lines 6 – 17).

Regarding claim 9, Resnick teaches a method wherein the payer's account and

payee or merchant's account is a prepaid telephone or wireless telephone

service account linked to their sub account.

Regarding claim 10, Resnick teaches a method wherein said communicating

data indicative of the payment transaction and mobile telephone account from

the point-of-sale to the payment processor includes communicating the data from

the point-of sale over a network to the payment processor (Para 006 and Figure

2).

Regarding claim 11 and related claims 12, 13 and 14, method's wherein the

communicating step includes responding with an activation code being sent to

the point of sale over a network from the payment processor and (claim 12)

wherein said communicating step includes requesting the previously sent

activation code to be responded by payer either by voice or by keying into the

mobile keypad upon successful connecting to the user's mobile communication

device to the payment processor being sent over a network, responding with an

activation code as well as a keypad are all well known in the art. In that regard,

one of ordinary skill in the art would have been motivated to extend the

combination of Reisman and Katz with these techniques to reduce fraud and

increase security for all participants. Moreover, the communicating step(s) is only

data, which is considered non-functional descriptive material. The phrase(s) and

or word(s) are given little patentable weight because the claim language

limitation is considered to be non-functional descriptive material, which does not

patentably distinguish the applicant's invention from Resnick as well as Katz.

Thereby, the non-fictional descriptive material is directed only to the content of

the data being transmitted and does not affect either the structure or

method/process of Resnick, which leaves the method and system unchanged.

Regarding claim 15, Katz teaches a method where upon receiving the successful

authorization from the payer's carrier, payment processor will credit the payee's

telecommunication sub account and debit the payer's telecommunication sub

account, the communicating steps include sending encrypted text receipts to

payer's mobile devices and payee's server over the network as confirmation (Col

10, lines 10 - 28.

Regarding claim 16, Resnick teaches a method according wherein said

communicating data indicative of the transaction from the point-of-sale to the

centralized payment processor; communicating a transaction message indicating

the amount of the payment, the identity of the telecommunication payer account

holder, the identity of the payee from the point-of-sale to the payment processor.

(Abstract and Figure 2).

Regarding claim 18, Katz teaches a method and further comprising settling the

payment transaction by receiving confirmation of debiting an amount of money

equal to the payment amount in payer's sub account, subject to adjustment, from

the payer's telecommunication service provider and a confirmation of crediting

the said amount subject to adjustment, into the payee's telecommunication

account by book entry from payee's telecommunication service provider (Col.

Regarding claim 19, Katz teaches a method including, in the payment processor,

maintaining a database of payers' telecommunication accounts and a list

telecommunication accounts of participating payees linked to each transaction

unique identifier for the purposes of reconciliation and profiling of users (Col 5,

lines 12 – 17).

Regarding claim 20, Katz t teaches a method and further comprising a customer

interface comprising an interactive voice response module (Col 6, line 34).

Conclusion

An examination of this application reveals that applicant is unfamiliar with

patent prosecution procedure. While an inventor may prosecute the application,

lack of skill in this field usually acts as a liability in affording the maximum

protection for the invention disclosed. Applicant is advised to secure the services

of a registered patent attorney or agent to prosecute the application, since the

value of a patent is largely dependent upon skilled preparation and prosecution.

The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and

Agents Registered to Practice Before the U.S. Patent and Trademark Office."

This publication is for sale by the Superintendent of Documents, U.S.

Government Printing Office, Washington, D.C. 20402.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to **Rob Rhode** whose telephone number is

(703) 305-8230. The examiner can normally be reached Monday thru Friday

8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application

or proceeding should be directed to the **Receptionist** whose telephone number

is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306   [Official communications; including

After Final communications labeled

"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451

Crystal Drive, Arlington, VA, 7th floor receptionist.

RER

Jeffrey A. Smith
Primary Examiner